

REMARKS

In the Office Action, the Examiner indicates that claims 1 and 4-6 are pending in this application. Applicants respectfully note, however, that claim 7 was added in the Preliminary Amendment filed with the RCE on April 10, 2003. A copy of this Preliminary Amendment, along with the date-stamped postcard from the U.S. Patent and Trademark Office, is attached. Applicants respectfully request that the Examiner correct the error and indicate that claim 7 has been considered with the other claims.

With entry of this response, claims 1 and 7 are amended and no claims are canceled or added. Thus, claims 1 and 4-7 are pending.

The Claims Are Enabled

The Examiner rejects claims 1 and 4-6, under 35 U.S.C. § 112, second paragraph, as allegedly not being enabled. Office Action, page 2. According to the Examiner, the claims are enabled for treating gastrointestinal disease, but not for preventing such diseases. *Id.*

Applicants respectfully disagree. However, solely to further prosecution of this application, Applicants have amended claim 1. The term "preventing" has been removed from the claims. Applicants reserve the right to pursue the canceled subject matter in one or more divisional applications at a later date. Each of the presently amended claims is now directed to methods of treatment, but not prevention. The Office has acknowledged that such methods are enabled. *Id.* Accordingly, Applicants respectfully request that the Examiner withdraw the enablement rejection and allow the amended claims.

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The Claims Are Not Obvious Over Buzas et al.

The Examiner rejects claims 1 and 4-6, under 35 U.S.C. § 103(a), as allegedly being unpatentable over Buzas *et al.* (RO 92436). Office Action, page 6. According to the Office, the abstract of this Romanian publication describes a composition comprising a carbonic anhydrase inhibitor and a beta-blocker to treat gastritis, gastro-duodenitis, and gastro-duodenal ulcers. *Id.* The Office acknowledges that Buzas does not teach any use of S(-) pindolol. However, the Office asserts that since pindolol is known to be an antagonist of 5HT1a receptors, "it is reasonable to expect that S(-) pindolol would also have those properties." *Id.* Thus, the Office concludes that it would be obvious to use S(-) pindolol in place of pindolol to practice the teachings of Buzas. *Id.*

In order to more completely discuss the teachings of Buzas and give context to the Abstract cited by the Office, Applicants obtained an English translation of the entire Romanian publication ("Buzas Translation"). That translation is submitted herewith in an Information Disclosure Statement.

Applicants contend that Buzas does not render the present claims obvious. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the teachings of Buzas in the manner proposed by the Office. Moreover, the prior art must teach all of the elements of the present claims. Finally, the prior art must also provide a reasonable expectation of success. See M.P.E.P. § 2143. The suggestion or motivation must be found in the prior art, not in Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir.

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1991). And the suggestion to combine or modify the prior art's teachings must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

Applicants contend that the Office has failed to establish a *prima facie* case of obviousness. There simply is no clear and particular suggestion in the prior art to modify Buzas in the manner proposed by the Office. Buzas describes a synergistic composition containing a carbonic anhydrase inhibitor and a beta-adrenergic blocker in a specific weight ratio. Buzas Translation, page 2. According to Buzas, the object of the invention is to obtain a synergistic composition through the "selection of ingredients and the mixture ratio thereof." *Id.* Buzas then provides 28 examples of various combinations of ingredients and weight ratios. *Id.*, pages 2-5.

Applicants note, however, that Buzas is directed solely to combinations of compounds. Buzas does not teach or suggest the use of use of any beta-blocker compound as an effective mono-therapy for any disease. Quite to the contrary, Buzas suggests that beta-blockers, when used alone, are not effective as a treatment for duodenal ulcers. See Table 3, page 8. According to Buzas, only after combining beta-blockers with a carbonic anhydrase inhibitor (acetazolamide or ethoxzolamide) does one achieve a therapeutic effect. See Table 9, page 12. Thus, Buzas reports that the synergistic combination might be therapeutic, but suggests that beta-blockers alone are not. Thus, one of skill in the art receives no guidance to suggest using a beta-blocker as a mono-therapy for GI conditions.

After considering the totality of the Buzas publication, several conclusions follow. First, there is clearly no motivation to modify the teaching of Buzas to use beta-blockers

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as a mono-therapy for GI conditions. As noted above, such a position runs directly counter to Buzas' actual data, which is focused solely on combination therapy and suggests that beta-blockers by themselves are not effective.

Second, there is no reasonable expectation of success to support modifying the teachings of Buzas in the manner proposed by the Office. Buzas suggests that beta-blockers alone are not an effective treatment for the one condition tested (duodenal ulcers). Given such guidance, one of skill in the art would have no reasonable expectation of successfully using pindolol or racemic pindolol to treat the same disorder (without first proving that Buzas was wrong).

Finally, the teachings of Buzas do not disclose every element of the presently claimed invention. The entirety of Buzas' work is directed at combinations of drugs. Applicants' invention is specifically directed to the use of S(-) pindolol, and does not require the presence of other therapeutic compounds in order to achieve its effect. Buzas does not describe the use of beta-blockers alone, much less stereoisomers of those beta-blockers, as a therapy for GI conditions. In other words, Buzas' synergistic composition therapy does not necessarily disclose the individual use of the components of that composition. Thus, Buzos fails to teach all of the elements of the present claims.

For these reasons, Applicants respectfully request that the Office withdraw the rejection of claims 1 and 4-6, under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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